

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte DONNA L. SIEMERS

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Appeal No. 1998-2849  
Application No. 08/584,158<sup>1</sup>

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ON BRIEF

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Before CALVERT, MEISTER, and NASE, Administrative Patent Judges.  
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 35 through 74, which are all of the claims pending in this application.<sup>2</sup>

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<sup>1</sup> Application for patent filed January 11, 1996. According to the appellant, the application is a continuation of Application No. 08/176,802, filed January 3, 1994, now abandoned.

<sup>2</sup> We note that the appellant has requested an oral hearing (part of Paper No. 23, filed May 11, 1998), but under the circumstances a hearing is not considered necessary. See 37 CFR § 1.194(c), last sentence, as amended effective Dec. 1, (continued...)

We REVERSE and enter a new rejection pursuant to 37 CFR § 1.196(b).

BACKGROUND

The appellant's invention relates to a method or game process for measurement of the emotional distance between two or more preselected individuals. A copy of the claims under appeal appears in the appendix to the appellant's brief.

The prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Wright	4,893,819	Jan. 16,
1990		

Claims 35 through 74 stand rejected under 35 U.S.C. § 101 as being drawn to non-statutory subject matter.

Claims 35 through 74 stand rejected under 35 U.S.C. § 112, first paragraph, as the specification, as originally

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<sup>2</sup>(...continued)  
1997, by final rule notice, 62 Fed. Reg. 53131 (Oct. 10, 1997), 1203 Off. Gaz. Pat. Office 63, (Oct. 21, 1997).

filed, does not provide support for the invention as is now claimed.

Claims 35 through 74 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellant regards as the invention.

Claims 35 through 37, 39 and 41 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Wright.

Claims 38, 40 and 42 through 61 stand rejected under 35 U.S.C. § 103 as being unpatentable over Wright.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the final rejection in the parent application (Paper No. 8, mailed February 6, 1995), the final rejection in this application (Paper No. 16, mailed July 2, 1996) and the examiner's answer (Paper No. 22, mailed March 9, 1998) for the examiner's complete reasoning in support of

the rejections, and to the appellant's brief (Paper No. 19, filed June 3, 1997) and reply brief (Paper No. 23, filed May 11, 1998) for the appellant's arguments thereagainst.

#### OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art reference, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

#### **The indefiniteness issues**

We will not sustain the rejection of claims 35 through 74 under 35 U.S.C. § 112, second paragraph.

The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). In making this determination, the definiteness of the language

employed in the claims must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. Id.

The examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. § 112, second paragraph, is whether the claims meet the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available. Some latitude in the manner of expression and the aptness of terms is permitted even though the claim language is not as precise as the examiner might desire. If the scope of the invention sought to be patented can be determined from the language of the claims with a reasonable degree of certainty, a rejection of the claims under 35 U.S.C. § 112, second paragraph, is inappropriate.

With this as background, we find ourselves in agreement with the appellant's position (brief, pp. 18-20) that the

claims under appeal are not indefinite for the reasons set forth by the examiner in his specific objections set forth in the final rejection in the parent application (Paper No. 8). In that regard, it is our opinion that the metes and bounds of the terms used in the claims on appeal (e.g., emotional distance, behavior type category, etc.) would be known with a reasonable degree of precision and particularity in view of the teachings of the originally filed application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. Accordingly, the decision of the examiner to reject claims 35 through 74 under 35 U.S.C. § 112, second paragraph, is reversed.

**The written description issue**

We will not sustain the rejection of claims 35 through 74 under 35 U.S.C. § 112, first paragraph.

The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the **later claimed subject matter**, rather than the presence or absence of literal support in the specification for the claim language. See Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1116-17 (Fed. Cir. 1991) and In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983).

In addition, the examiner has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims. In re Wertheim, 541 F.2d 257, 265, 191 USPQ 90, 98 (CCPA 1976); Ex parte Sorenson, 3 USPQ2d 1462, 1463 (Bd. Pat. App. & Int. 1987).

In our view, the examiner has not met this initial burden of presenting evidence or reasons why persons skilled in the art

would not recognize in the appellant's disclosure a description of the invention defined by the claims. In this regard, we note that the examiner has not (1) identified the claim limitation not described; and (2) provided reasons why persons skilled in the art at the time the application was filed would not have recognized the description of the claimed limitations in the disclosure of the application as filed.

We have reviewed the specific concern stated by the examiner in this rejection (i.e., the addition of two paragraphs to pages 16 and 26 of the specification), but find nothing therein which supports a rejection based upon the written description requirement of 35 U.S.C. § 112, first paragraph. In this case, the examiner has not even identified the specific language in those paragraphs that constitutes the alleged "new matter." In any event, it is our opinion that the meaning of the claimed phrase "emotional distance" as understood by one of ordinary level of skill in the art is not



altered by these two paragraphs. Thus, there is no basis for a rejection of claims 35 through 74 based upon the written description requirement of 35 U.S.C. § 112, first paragraph.

For the reasons stated above, the decision of the examiner to reject claims 35 through 74 under 35 U.S.C. § 112, first paragraph, is reversed.

**The non-statutory subject matter issue**

We will not sustain the rejection of claims 35 through 74 under 35 U.S.C. § 101.

Section 101 of title 35, United States Code, provides:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The Supreme Court has held that Congress chose the expansive language of 35 U.S.C. § 101 so as to include

"anything under the sun that is made by man." Diamond v. Chakrabarty, 447 U.S. 303, 308-09 (1980).

This perspective has been embraced by the Federal Circuit:

The plain and unambiguous meaning of 101 is that any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may be patented if it meets the requirements for patentability set forth in Title 35, such as those found in ' 102, 103, and 112. The use of the expansive term "any" in 101 represents Congress's intent not to place any restrictions on the subject matter for which a patent may be obtained beyond those specifically recited in 101 and the other parts of Title 35. . . . Thus, it is improper to read into 101 limitations as to the subject matter that may be patented where the legislative history does not indicate that Congress clearly intended such limitations. [In re Alappat, 33 F.3d 1526, 1542, 31 USPQ2d 1545, 1556 (Fed. Cir. 1994) (in banc)]

As cast, 35 U.S.C. § 101 defines four categories of inventions that Congress deemed to be the appropriate subject matter of a patent; namely, processes, machines, manufactures and compositions of matter. The latter three categories define "things" while the first category defines "actions" (i.e., inventions that consist of a series of steps or acts to be performed). See 35 U.S.C. § 100(b) ("The term 'process'

means process, art, or method, and includes a new use of a known process, machine, manufacture, composition of matter, or material.").

The Supreme Court has identified three categories of subject matter that are unpatentable, namely "laws of nature, natural phenomena, and abstract ideas." Diamond v. Diehr, 450 U.S. 175, 185 (1981).

In this case, the claims under appeal are clearly drawn to a process and thus constitute statutory subject matter under 35 U.S.C. § 101. In addition, we note that, contrary to the opinion of the examiner, the mere fact that some of the process steps set forth in the claims under appeal require the intervention of an individual (i.e., a human being) to perform does not make the claimed subject matter non-statutory.

For the reasons set forth above, the decision of the examiner to reject claims 35 through 74 under 35 U.S.C. § 101 is reversed.

**The anticipation issue**

We will not sustain the rejection of claims 35 through 37, 39 and 41 under 35 U.S.C. § 102(b).

To support a rejection of a claim under 35 U.S.C. § 102(b), it must be shown that each element of the claim is found, either expressly described or under principles of inherency, in a single prior art reference. See Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

We agree with the appellant's argument (brief, pp. 21-22) that the methods disclosed by Wright are quite different from the method set forth in claims 35 through 37, 39 and 41. Specifically, it is our opinion that steps (b), (d) and (e) of independent claim 35 are not disclosed by Wright.

Since all the limitations of claims 35 through 37, 39 and 41 are not found in Wright for the reasons set forth above, the decision of the examiner to reject claims 35 through 37, 39 and 41 under 35 U.S.C. § 102(b) is reversed.

**The obviousness issue**

We will not sustain the rejection of claims 38, 40 and 42 through 61 under 35 U.S.C. § 103.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. See In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is prima facie obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

We agree with the appellant's argument (brief, p. 23) that Wright does not teach or suggest the claimed subject matter set forth in claims 38, 40 and 42 through 61. Specifically, it is our opinion that steps (b), (d) and (e) of independent claim 35, steps (b), (d), (e) and (f) of independent claim 49, and steps (b), (d), (e), (f) and (g) of independent claim 59 would not have been obvious to one of ordinary skill in the art at the time the invention was made from Wright's disclosure.

For the reasons stated above, the decision of the examiner to reject claims 38, 40 and 42 through 61 under 35 U.S.C. § 103 is reversed.

**New ground of rejection**

Under the provisions of 37 CFR § 1.196(b), we enter the following new ground of rejection.

Claim 57 is rejected under 35 U.S.C. § 112, fourth paragraph, as being of improper dependent form for failing to further limit the subject matter of a previous claim.

35 U.S.C. § 112, fourth paragraph, states

Subject to the following paragraph, a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.

A claim that incorporates by reference all of the subject matter of another claim, that is, the claim is not broader in any respect, to be in compliance with the fourth paragraph of 35 U.S.C. § 112. See Ex parte Porter, 25 USPQ2d 1144 (Bd. Pat. App. & Int. 1992) and Ex parte Moelands, 3 USPQ2d 1474 ((Bd. Pat. App. & Int. 1987)).

Claim 57 recites

The method as set forth in claim 56, wherein the step of recording a preferred response from said selection of possible responses from each of said two or more preselected individuals **is replaced by** the step of requiring each of said two or more preselected individuals to provide their own preferred response.  
[emphasis ours]

It is our determination that the appellant's use of the phrase "**is replaced by**" in claim 57 causes claim 57 to violate the fourth paragraph of 35 U.S.C. § 112. In that regard, the phrase "**is replaced by**" in claim 57 causes claim 57 to not include **all** the limitations of the claim to which it refers.

#### CONCLUSION

To summarize, the decision of the examiner to reject claims 35 through 74 under 35 U.S.C. § 101 is reversed; the decision of the examiner to reject claims 35 through 74 under 35 U.S.C. § 112, first paragraph, is reversed; the decision of the examiner to reject claims 35 through 74 under 35 U.S.C. § 112, second paragraph, is reversed; the decision of the examiner to



reject claims 35 through 37, 39 and 41 under 35 U.S.C. § 102(b) is reversed; the decision of the examiner to reject claims 38, 40 and 42 through 61 under 35 U.S.C. § 103 is reversed; and a new rejection of claim 57 under 35 U.S.C. § 112, fourth paragraph, has been added pursuant to provisions of 37 CFR § 1.196(b).

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53131, 53197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new

ground of rejection to avoid termination of proceedings

(§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

No time period for taking any subsequent action in  
connection with this appeal may be extended under 37 CFR  
§ 1.136(a).

REVERSED; 37 CFR § 1.196(b)

IAN A. CALVERT	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
JAMES M. MEISTER	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
JEFFREY V. NASE	)	
Administrative Patent Judge	)	

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APPLICATION NO. 08/584,158

APJ NASE

APJ CALVERT

APJ MEISTER

DECISION: **REVERSED;**  
**37 CFR § 1.196(b)**

Prepared By: Gloria Henderson

**DRAFT TYPED:** 05 May 99

**FINAL TYPED:**

**Gloria: Change the order of the panel.**